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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,387	10/31/2000	Hiroshi Yoshino	1272.7623 Div.1	3308

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EXAMINER

NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2863

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,387

Applicant(s)

YOSHINO, HIROSHI

Examiner

Michael P Nghiem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/522,917.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The Response filed on December 27, 2002 has been acknowledged.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 8-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8-10, 15, and 16 of U.S. Patent No. 6,155,666 (Sugimoto et al.) in view of US 6,252,615 (Yoshino). Even though Sugimoto et al. does not claim that the waste liquid accommodating substance is formed in a U-shaped configuration, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide

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Sugimoto et al. with a U-shaped waste liquid accommodating substance as disclosed by Yoshino (Fig. 8) for the purpose of separating liquid ink from liquid waste.

Response to Arguments

3. Applicant's arguments filed on December 27, 2002 have been fully considered but they are not persuasive.

With respect to the obvious-type double patenting rejection, Applicants argue that none of the independent claims 1, 8-10, 15, and 16 of Sugimoto are seen to disclose the foregoing features of independent claim 8. Claim 8 of the present invention does not introduce waste liquids to a waste tank, but instead introduce them to a first and second portion of a waste liquid accumulation substance.

Examiner's position is that claim 1 of Sugimoto discloses introducing waste liquids to a first and second portions of a waste liquid accumulation substance (column 59, lines 5-8, 16-19).

Applicants further argue that claim 8 of the present invention does not claim that the first and second portions of the waste liquid accommodating substance are separated by a boundary at which ink and liquid contact each other as disclosed in claim 1 of Sugimoto. Examiner's position is that claim 8 of the present invention claims that the first and second portions of the waste liquid accommodating substance (first portion of waste liquid accommodating substance containing waste ink, lines 7-9, and second portion of

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waste liquid accommodating substance containing waste liquid, lines 10-13) are separated (line 11) by a boundary at which ink and liquid contact each other (boundary in substance where waste ink and liquid will eventually meet when substance is full of waste).

Applicants further argue that claim 1 of Sugimoto is different in scope than claim 8 of the present invention since claim 1 of Sugimoto includes insoluble and coagulated ink, an ink receiver, liquid receiver, and a waste tank, none of which are seen to be claimed in claim 8 of the present invention.

Examiner's position is that claim 8 of the present invention claims insoluble and coagulated ink (setting of ink, line 2), an ink receiver (means for performing recovery operations from ink port, lines 6-7), liquid receiver (means for performing recovery operation from liquid port, lines 10-11), and a waste tank (waste containing portion of waste liquid accommodating substance, line 5).

Applicants further argue that the claims of Sugimoto are not seen to contain such a combination as that of claim 13 of the present invention.

Examiner's position is similar to the discussion above with respect to claim 8 of the present invention. Thus, the claims of Sugimoto contain such a combination as that of claim 13 of the present invention.

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Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (703) 306-3445. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-5841 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



MICHAEL NGHIEM
PRIMARY EXAMINER

Michael Nghiem

February 25, 2003